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10/571,197

03/09/2006

Hiroto Kidokoro

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07/17/2008

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EXAMINER

LE, HOA VAN

ART UNIT

PAPER NUMBER

1795

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                      |                                         |  |
|------------------------------|--------------------------------------|-----------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/571,197 | <b>Applicant(s)</b><br>KIDOKORO, HIROTO |  |
|                              | <b>Examiner</b><br>Hoa V. Le         | <b>Art Unit</b><br>1795                 |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                        |                                                                   |
|----------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. ____.                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>03/09/08</u> .                                                | 6) <input type="checkbox"/> Other: ____.                          |

This application is up for consideration on the merits.

I. Applicants' prior art submission has been considered to the extent of the English language as provided.

II. It is lucky that the Office is timely found and applied the closely related claimed invention.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-15 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-8 and (the broad teachings and suggestion in the specification of copending Application

No.10/549,144 having Pub. No. 2006/0154163. Therefore, application is not required to doubly cited. For the broad teachings and/or suggestion in the specification, please see at least paragraphs 0035 to 0042, 0049, 0051, 0062 to 0066, 0071 to 0082 and examples. However, applicants, assignee and/or their counsel may disagree and state on and for the record that each of the original claims is self supported. There has not been and will not be relied on any embodiment in any application for any purpose). The language “circularity in the range...”, “zeta potential...”, “soluble component in tetrahydrofran...”, “charge control resin having an acid value...”, “an extract liquid...”, “the  $\sigma$ ...”, “multifunctional eater compound having a hydroxyl value...” or the like is a property or measurement of a property of a material. For a patentability of the property or measurement of a property of a material, it is allowed be law to request and require applicants to convincingly provide an evidence to the contrary since arguments alone is not a factual evidence. An allowed claim or patent would have no value when someone reasonably shows that there is reasonably a property as claimed using all possible combinations of the broad teachings and/or suggestions in the applied specification. A showing should be submitted in the next response to this Office action in order for it to be considered timely. In the absence of a convincing evidence, claims 1-15 are not allowable the teachings and/or suggestion

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in the application. An allowed claim or patent would have no value when someone reasonably shows that there is reasonably at least the broad teachings and/or suggestions in the applied reference are read on one of the instant claims without a terminal disclaimer. One should look in to this issue since a benefit may be found and obtained.

Although the conflicting claims are not identical, they are not patentably distinct from each other because it is found that the broad teachings and/or suggestions in the applied specification are broadly enough to read on the instant claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

III. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4 and 7-15 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Masuo et al (PCT Pub. No. WO00/58790 being published on Oct. 5, 2000 with its English language equivalent US Patent No. 6,562,535 to the same Zeon assignee as that in this

application. Therefore, copy of PCT Pub. No. WO00/58790 in Japanese language is not required to provide).

Masuo et al disclose and teach an electrographic toner composition comprising a binder resin and a colorant and having an average particle size of up to about 7 microns and spherical shape (dl/ds) of from 1 to 1.3. Please see the whole disclosure of the applied reference, especially at least on col.4:19-29, 34 to 11:8, 20 to 12:47, 13:1-33, 18:57-63 and Examples. The language “circularity in the range...”, “zeta potential...”, “soluble component in tetrahydrofran...”, “charge control resin having an acid value...”, “an extract liquid...”, “the  $\sigma$ ...” or the like is a property or measurement of a property of a material. For a patentability of the property or measurement of a property of a material, it is allowed be law to request and require applicants to convincingly provide an evidence to the contrary since arguments alone is not a factual evidence. An allowed claim or patent would have no value when someone reasonably shows that there is reasonably a property as claimed using all possible combinations of the broad teachings and/or suggestions in the applied Masuo et al. A showing should be submitted in the next response to this Office action in order for it to be considered timely. In the absence of a convincing evidence, claims 1-4 and 7-15 are not allowable and are found to be anticipated by Masuo et al.

In an alternative, the broad teachings and/or suggestions and obviously about the same claimed property are found to be rendered prima facie obvious by Masuo et al.

IV. Claims 5-6 are rejected under 35 U.S.C. 103(a) as obvious over Masuo et al (PCT Pub. No. WO00/58790 being published on Oct. 5, 2000 with its English language equivalent US Patent No. 6,562,535 to the same Zeon assignee as that in this application. Therefore, copy of PCT Pub. No. WO00/58790 in Japanese language is not required to provide) considered in view of Takasaki (PCT Pub. No. WO00/13063 being published on Mar. 9, 2000 with its English language equivalent US Patent No. 6,649,315 to the same Zeon assignee as that in this application. Therefore, copy of PCT Pub. No. WO00/58790 in Japanese language is not required to provide)

Masuo et al disclose and teach an electrographic toner composition comprising a binder resin and a colorant and having an average particle size of up to about 7 microns and spherical shape (dl/ds) of from 1 to 1.3. Please see the whole disclosure of the applied reference, especially at least on col.4:19-29, 34 to 11:8, 20 to 12:47, 13:1-33, 18:57-63 and Examples. The language “circularity in the range...”, “zeta potential...”, “soluble component in tetrahydrofran...”,

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“charge control resin having an acid value...”, “an extract liquid...”, “the  $\sigma$ ...” or the like is a property or measurement of a property of a material. For a patentability of the property or measurement of a property of a material, it is allowed by law to request and require applicants to convincingly provide an evidence to the contrary since arguments alone is not a factual evidence. An allowed claim or patent would have no value when someone reasonably shows that there is reasonably a property as claimed using all possible combinations of the broad teachings and/or suggestions in the applied Masuo et al. A showing should be submitted in the next response to this Office action in order for it to be considered timely. In the absence of a convincing evidence, claims 1-4 and 7-15 are not allowable over the applied Masuo et al.

Masuo et al disclose, teach and suggest the use multiple parting agents but do not specify a known plural ester containing parting agent. However, it is known to use one or more plural ester containing parting agents in the art at the time the invention was made. Evidence can be seen in at least Takasaki on at least col.11:64-66 for an advantage of an anti-upsetting property in the art at the time the invention was made. The language "multifunctional ester compound having a hydroxyl value..." or the like is a property or measurement of a property of a material. For a patentability of the property or measurement of a property of a



material, it is allowed by law to request and require applicants to convincingly provide an evidence to the contrary since arguments alone is not a factual evidence. An allowed claim or patent would have no value when someone reasonably shows that there is reasonably a property as claimed using all possible combinations of the broad teachings and/or suggestions in the applied Takasaki. A showing should be submitted in the next response to this Office action in order for it to be considered timely. In the absence of a convincing evidence, claims 5-6 are not allowable over the applied Takasaki.

Since the above references are all related to electrographic toner compositions, it would have been obvious to one having ordinary skill in the art at the time the invention was made to collectively use or cite the known plural ester containing parting agent for a reasonable expectation of obtaining an anti-upsetting property as used and reduced to practice in Takasaki.

V. Claims 1-15 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Takasaki (PCT Pub. No. WO00/13063 being published on Mar. 9, 2000 with its English language equivalent US Patent No. 6,649,315 to the same Zeon assignee as that in this

application. Therefore, copy of PCT Pub. No. WO00/58790 in Japanese language is not required to provide).

Takasaki discloses and teaches an electrographic toner composition comprising a binder resin and a colorant and having an average particle size of about 6-9 microns and spherical shape (dl/ds) of from 1 to 1.3. Please see the whole disclosure of the applied reference, especially at least on col.7:20, 58-60, 8:48 to 11:12, 22 to 12:9 and Examples. The language “circularity in the range...”, “zeta potential...”, “soluble component in tetrahydrofran...”, “charge control resin having an acid value...”, “an extract liquid...”, “the  $\sigma$ ...”, “multifunctional eater compound having a hydroxyl value...” or the like is a property or measurement of a property of a material. For a patentability of the property or measurement of a property of a material, it is allowed be law to request and require applicants to convincingly provide an evidence to the contrary since arguments alone is not a factual evidence. An allowed claim or patent would have no value when someone reasonably shows that there is reasonably a property as claimed using all possible combinations of the broad teachings and/or suggestions in the applied Takasaki. A showing should be submitted in the next response to this Office action in order for it to be considered timely. In the absence of a convincing evidence, claims 1-15 are not allowable and are found to be anticipated by Takasaki.

In an alternative, the broad teachings and/or suggestions and obviously about the same claimed property are found to be rendered prima facie obvious by Takasaki.

VI. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-8 and 10-15 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Tomita et al (2004/0053154).

Tomita et al disclose and teach an electrographic toner composition comprising a binder resin and a colorant and having an average particle size of up to about 7 microns and circularity of from 0.930 to 0.990. Please see the whole disclosure of the applied reference, especially at least on paragraphs 0062, 0067, 0069, 0082 to 0130, 0134, 0142 and Examples. The language “zeta potential...”, “soluble component in tetrahydrofran...”, “charge control resin having an acid value...”, “multifunctional eater compound having a hydroxyl value...”, “an

extract liquid...”, “the  $\sigma$ ...” or the like is a property or measurement of a property of a material. For a patentability of the property or measurement of a property of a material, it is allowed by law to request and require applicants to convincingly provide an evidence to the contrary since arguments alone is not a factual evidence. An allowed claim or patent would have no value when someone reasonably shows that there is reasonably a property as claimed using all possible combinations of the broad teachings and/or suggestions in the applied Tomita et al. A showing should be submitted in the next response to this Office action in order for it to be considered timely. In the absence of a convincing evidence, claims 1-8 and 10-15 are not allowable and are found to be anticipated by Tomita et al.

In an alternative, the broad teachings and/or suggestions and obviously about the same claimed property are found to be rendered prima facie obvious by Tomita et al.

VII. Claims 1-8 and 10-15 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Tomita et al (2004/0053154) considered in view of Masuo et al (PCT Pub. No. WO00/58790 being published on Oct. 5, 2000 with its English language equivalent US Patent No. 6,562,535 to the same Zeon assignee as that in this application.

Therefore, copy of PCT Pub. No. WO00/58790 in Japanese language is not required to provide) or Takasaki (PCT Pub. No. WO00/13063 being published on Mar. 9, 2000 with its English language equivalent US Patent No. 6,649,315 to the same Zeon assignee as that in this application. Therefore, copy of PCT Pub. No. WO00/58790 in Japanese language is not required to provide).

Tomita et al disclose and teach an electrographic toner composition comprising a binder resin and a colorant and having an average particle size of up to about 7 microns and circularity of from 0.930 to 0.990. Please see the whole disclosure of the applied reference, especially at least on paragraphs 0062, 0067, 0069, 0082 to 0130, 0134, 0142 and Examples. The language “zeta potential...”, “soluble component in tetrahydrofran...”, “charge control resin having an acid value...”, “multifunctional eater compound having a hydroxyl value...”, “an extract liquid...”, “the  $\sigma$ ...” or the like is a property or measurement of a property of a material. For a patentability of the property or measurement of a property of a material, it is allowed be law to request and require applicants to convincingly provide an evidence to the contrary since arguments alone is not a factual evidence. An allowed claim or patent would have no value when someone reasonably shows that there is reasonably a property as claimed using all possible combinations of the broad teachings and/or suggestions in the applied Tomita et al.

A showing should be submitted in the next response to this Office action in order for it to be considered timely. In the absence of a convincing evidence, claims 1-8 and 10-15 are not allowable over by Tomita et al.

Tomita et al disclose, teach and suggest the of a charge control polymer but does not specify polymer molecular weight. However, it is known to make, obtain and use a charge control polymer having a molecular weight within in the range as claimed for an advantage of having a melting range within a fixing temperature to one having ordinary skill in the art at the time the invention was made. Evidence can be seen in at least Masuo et al on at least col.4:35 to 11:2 or Takasaki on at least col.11:41 to 60.

Since the above references are all related to electrographic toner compositions, it would have been obvious to one having ordinary skill in the art at the time the invention was made to collectively use or cite the known polymer charge control molecular weight for a reasonably expectation of obtaining an a stable charge and melting temperature within a fixing temperature as made, obtained, used and reduced to practice in Masuo et al or Takasaki.

VIII. When each of all of the above applied references are overcome by an amendment or showing under Rule 132 as clearly pointed out and set forth above,

one or more of the following and cumulative references are in line to be applied.

They are: 6638674, 7056638, 7171151, 2002/0115011, 2003/0096185,  
2003/0152856, 2005/0164114.

IX. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V. Le whose telephone number is 571-272-1332.

The examiner can normally be reached from 6:30 AM to 4:30 PM on Monday through Thursday and about the same time of most Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526.

Applicants may file a paper by (1) fax with a central facsimile receiving number 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private

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PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Hoa V. Le/

Primary Examiner, Art Unit 1795

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